

REMARKS

The Office Action of February 21, 2006, has been considered by the Applicants. None of the claims have been amended or cancelled. Claims 1-8, 13-21, and 23-31 remain pending. Reconsideration of the Application is requested.

In the Office Action, the rejection of claims 1-8, 10-21, 23, 24, and 26-31 under 35 U.S.C. 103(a) as allegedly being obvious over Drappel was maintained. Applicants traverse the rejection.

According to the Examiner, Drappel teaches various ranges for triboelectric charge value and conductivity. Because the concentration of conductive polymer is a result-effective variable for these two results, the claimed 0.1 wt% would be found through routine experimentation.

Applicants respectfully submit that the Examiner's interpretation does not consider the reference as a whole. MPEP § 2141(II). Under the Examiner's interpretation, the skilled artisan would read Drappel and desire to achieve the stated triboelectric charge value and conductivity, but would ignore Drappel's teaching that a range of about 5 to about 70 weight percent of conductive polymer will achieve the stated triboelectric charge value and conductivity. In other words, the artisan considers *what* to achieve, but ignores *how* to achieve it. This does not consider the reference as a whole.

The Examiner has not shown motivation for the artisan to work outside the range disclosed by Drappel. In all of the cases cited in MPEP § 2144.05(II), the prior art had provided a range of values for the result-effective variable and the claimed invention fell within that range. As stated in MPEP § 2144.05(II)(A), "the normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where *in a disclosed set of percentage ranges* is the optimum combination of percentages" (emphasis added). *In re Peterson*, 315 F.3d 1325, 65 USPQ2d 1379 (Fed. Cir. 2003). Drappel discloses a percentage range and Applicants agree it would be obvious to find the optimal value within that range. It is not obvious, however, to look

outside that range to find the optimal value. Because the claimed concentration of 0.1 wt% conductive polymer is outside the range disclosed by Drappel, it is not obvious.

For these reasons, Applicants request withdrawal of the § 103(a) rejection over Drappel.

The rejection of dependent claim 25 under 35 U.S.C. 103(a) as unpatentable over Drappel in view of Viswanathan (US 6,764,617) was maintained. Applicants traverse the rejection.

Viswanathan does not correct the deficiency of independent claim 1. Therefore, a *prima facie* case of obviousness does not exist. Withdrawal of the rejection is requested.


CONCLUSION

For the above reasons, it is submitted all pending claims (claims 1-8, 13-21, and 23-31) are in condition for allowance. Withdrawal of the rejections and issuance of a Notice of Allowance is requested.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he is hereby authorized to call Richard M. Klein, at telephone number 216-861-5582, Cleveland, OH.

Respectfully submitted,

FAY, SHARPE, FAGAN, MINNICH
& McKEE LLP



Richard M. Klein (Reg. No. 33,000)
1100 Superior Avenue, 7th Floor
Cleveland, OH 44114
(216) 861-5582